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EXAMINER

RAYYAN, SUSAN F

ART UNIT PAPER NUMBER

2177

DATE MAILED: 06/04/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/718,290

Applicant(s)

CASTLE, DANIEL C.

Examiner

Susan F. Rayyan

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:  
  
Group I, Claims 1-9, drawn to displaying, classified in class 715, subclass 517.  
  
Group II, Claims 10-49, drawn to delivery over a network, classified in Class 707, subclass 10.
2. The inventions are distinct, each from the other because of the following reasons:  
  
Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention in Group I has separate utility such as displaying data. The invention in Group II has a separate utility such as a delivery system. See M.P.E.P. 806.05(d).
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for the other Groups, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
6. During a telephone call with Jeff Limon, Reg. No. 45,418 on May 19, 2003 an election was made to Group II, with traverse.
7. **An election, with or without traverse, must be made by the Applicant in replying to this Office Action.**
8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

### ***Drawings***

9. The drawings are objected to because it fails to show necessary textual label of features or symbols in Fig. 2, 4A-4B as described in the specification. For example, placing a labels, such as "Denied Data", with elements 203 off Fig. 2 or "Specific Advertisement Profile" instead of SAP of Fig. 2, would give the viewer necessary detail to fully understand this element at a glance. A **descriptive** textual label for **each numbered element** in these figures would be needed to fully and better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be shown in the drawing. Optionally, applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.83. 37 CFR 1.84(n)(o) is recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if

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they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. **Claims 12,14-16,21,23-25,30,32-34,39,41-43,are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Regarding claim 12, 21,30,39 Examiner was unable to locate in the Specification the limitation "global content information". Examiner assume global content profile information (p.7, line 9-10 of Specification).

Regarding claim 14,23,32,41, Examiner was unable to locate in the Specification the limitation "global advertisement information" and "specific advertisement information". Examiner assumes global advertiser profile information (p.8, line 1 of Specification) and specific advertisement profile information (p. 8, line 4).

Regarding claim 15,24,33,42 Examiner was unable to locate in the Specification the limitations “behavior information” and “voluntary information”. Examiner assumes behavior profile information (p.8, line 12) and “voluntary profile information (p.8, line 22).

Regarding claim 16,25,34,43 Examiner was unable to locate in the Specification the limitations “descriptive information”, “desired information”, and “denied information”. Examiner assumes “descriptive data, desired data, and denied data (p.9, lines 4-5)

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. **Claims 11-12,20-21,29-30,38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 11,20,29,38 recites the limitation "the first type of content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding claims 12, 21,30,39, the limitation “global content information” and “advertisement hole profile information” is indefinite. Examiner finds the Specification’s description of the terms unclear (p.7, lines 6-25). Examiner interprets the global content information (global content profile information) to be profile information of the content used for example to determine the associated advertisement or selection of the content for inclusion in a search result. Advertisement hole profile information as profile information used to indicate

what the advertisement is related to in order to associated it with the correct type of informational content. Applicant is requested to clarify the meaning in the next response.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 10-11, 17-19,20,26-29,35-38,44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010).**

**As per independent claim 10,37 Dasan teaches:**

“A document delivery system for delivery of documents to a reader via a network” at Summary;

“a knowledge module containing profile information, including at least reader

“profile information” at col.5, lines 59-64 and col. 6, line 61, bridging to, col.7, line 21, fig. 4;

“an edit module containing first content” at col. col. 8, lines 29-39;

“a transmission module for transmitting the first content”... “ to a reader for display based upon the profile information” at col. 7, lines 52-52 and col. 8, lines 26-40;

“transmitting at least a portion of the reader profile information for display to the reader” at col. 8, lines 26-28 and fig.11.

Dasan does not explicitly teach “transmitting ...second content” however Hoyle does not explicitly teach second content at col.16, lines 28-41 and fig. 1. Thus it would have been obvious

to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col.16, lines 28-29, Abstract).

**As per claims 11,20,29,38 same as claim arguments above and Dasan teaches:**

“wherein the profile information includes content profile information corresponding to the first type of content” at col. 8, lines 26-28 and fig. 11.

**As per claim 17, 26,35,44 same as claim arguments above and Dasan teaches:**

“wherein the transmission module further transmits an interface usable by the reader to modify the reader profile information” at fig. 8.

**As per claim 18,27,36,45 same a claim arguments above and Dasan:**

“wherein the interface is a universal resource locator for a page usable by the reader to modify the reader profile information” at fig.8.

**As per independent claim 19 Dasan teaches:**

“a method of delivering informational content to a reader” at Summary;

“receiving profile information, including at least reader profile information

identifying content preferences for the reader” at col.5, line 65, bridging to, col. 6, line10;

“receiving first content” at col. 6, lines 11-18;

“transmitting to a reader the first content” ... “based on the profile information, and at least a portion of the reader profile information” at col. 7, lines 52-54 and col. 8, lines 26-40;



Dasan does not explicitly teach “receiving second content” however Hoyle does teach this limitation at col. 16, lines 28-41 and fig. 1. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col.16, lines 28-29, Abstract).

**As per independent claim 28 Dasan teaches:**

“a method of receiving content to read” at Summary;

“receiving a display of first content; at col. 6, lines 11-18;

“receiving a display of profile information, including at least reader profile information, related to the first or second content” at col. 7, lines 52-54 and col.8, lines 26-40.

Dasan does not explicitly teach “ receiving a display of second content” however Hoyle does teach this limitation at col. 16, lines 28-41. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to target advertisements in response to normal user interaction (Hoyle: col.16, lines 28-29, Abstract).

**As per claim 46 same as claim arguments above and Dasan:**

“wherein said edit means is comprised of a computer” at fig. 1-4.

**As per claim 47 same as claim arguments above and Dasan teaches:**

“wherein said knowledge storage means is comprised of a computer” at fig. 1-4.

**As per claim 48** same as claim arguments above and Dasan teaches:

“wherein said transmission means is comprised of a computer” at fig. 1-4.

**As per claim 49** same as claim argument above and Dasan teaches:

“wherein said transmission means is comprised of a data network” at fig. 1-4.

**16. Claims 12,21,30,39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) in view of Guyot et al. (US 6,119,098) and further in view of Barr (US 5873076).**

**As per claim 12, 21,30,39** same as claim arguments above and Dasan teaches “wherein the content profile information ...” at fig.10-12 however Barr teaches publication profile information at col.14, lines 15-46. Thus it would have been to combine Dasan, Hoyle, Guyot, and Barr to provide a means for the user to determine the relevancy of the content.

**17. Claims 13-14,22-23,31-32,40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) in view of Guyot et al. (US 6,119,098)**

**As per claim 13-14,22-23,31-32,40-41** same as claim arguments above and Dasan and Hoyle does not explicitly teach “wherein the profile information includes a advertisement profile information corresponding to the second content” and “wherein the advertisement profile information includes one or more types of information selected from the group consisting of: global advertisement information and specific advertisement information” however Guyot teaches this limitation at col. 3, line 66, bridging to col. 4, line 14. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention

to combine the cited references to identify the advertisers that provide the advertisement to the subscribers ( Guyot:col.3, line 66, bridging to, col.4, line 34).

**18. Claims 15,24,33,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) in view of Headerick et al. (US 6557006).**

**As per claim 15,24,33,42 same as claim arguments above and Dasan teaches** “voluntary information” at fig.8. Dasan does not explicitly teach “wherein the reader profile information includes one or more types of information selected from the group consisting of: behavior information” however Headerick does teach voluntary information and behavior information at col.8, lines 21-27. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to track demographic information (Headerick: col.8, line 19).

**19. Claims 16,25,34,43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan (US 576,1662) and Hoyle (US 614,1010) in view of Headerick et al. (US 6557006).**

**As per claim 16,25,34,43 same as claim arguments above and Dasan teaches:** “wherein the reader profile information includes one or more types of information selected from the group consisting of: descriptive information, desired information” at fig. 8. Dasan, Hoyle, Headerick do not explicitly teach “desired information” however Pierce doe teach this limitation at fig. 5. Thus it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine the cited references to efficiently search for desired data (Pierce: col.8, lines 46-51).

***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Rayyan whose telephone number is (703) 305-0311. The examiner can normally be reached M-F: 7am - 4:30pm, every other Friday off.

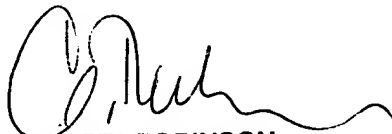
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746 -7239 for Official communications, (703) 746-7238 for After Final communications and (703) 746-7240 for Status inquires and draft communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Susan Rayyan



5/29/03



**GRETA ROBINSON  
PRIMARY EXAMINER**